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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,509	12/07/2000	Thomas Schaeck	DE919990082	1249
46369	7590	11/29/2004	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI P.C.			COLIN, CARL G	
5 COLUMBIA CIRCLE			ART UNIT	
ALBANY, NY 12203			PAPER NUMBER	

2136

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,509

Applicant(s)

SCHAECK ET AL.

Examiner

Carl Colin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. In response to communications filed on 8/6/2004, applicant cancels claims 1-15 and adds claims 16-47. The following claims 16-47 are presented for examination.
2. Applicant's arguments, pages 8-10, filed on 8/6/2004, with respect to the rejection of claims 1-15 have been fully considered, but they are moot in view of a new ground of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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3.1 **Claims 33, 40, and 47** are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,179,205 to **Sloan**.

3.2 **As per claims 33, 40, and 47, Sloan** discloses a method for controlling card holder verification comprising: obtaining by a device an identifier of a card usable with the device, for example (see abstract); searching one or more card identifier/personal identification number pairs for the identifier, for example (see abstract; column 5, line 44 through column 6, lines 18-45; and column 7, lines 8-28); sending the personal identification number associated with the searched identifier to the card and automatically performing card holder verification using the personal identification number wherein the automatically performing is absent card holder intervention, for example (see abstract and column 7, lines 8-28).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1 **Claims 16-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,979,773 to **Findley, Jr. et al** in view of US Patent 6,179,205 to **Sloan**.

4.2 As per claims 16, 18-19, 34-35, and 41-42, **Findley, Jr. et al** discloses a method for controlling card holder verification comprising: checking the presence of another card or presence of checking the presence of a trusted association between at least one device and a card usable with the at least one device, for example (see column 7, lines 14-67; column 1, lines 30-38) and discloses suppressing in response to the presence of the trusted association involvement of a holder of the card in performing card holder verification, for example (see column 2, lines 1-30 lines 35-58). It is apparent to one skilled in the art that the invention disclosed is automatic and there is no user involvement in performing card holder verification in response to the presence of a trusted association, for example (see column 7, lines 14-67). **Findley, Jr. et al** discloses the step of checking by comparing whether there is a match of data in the data fields between the card and the device used for verification. **Findley, Jr. et al** also discloses that password is also stored in the card. It would have been obvious to one skilled in the art that the matching of data field include verification of password or other personal identification number as it is known in the art as admitted in Applicant's prior art. To further support the checking the presence step, **Sloan** in an analogous art discloses a smart card that contains a card identification number and associated PIN number wherein the verification process is performed by comparing card ID and PIN with corresponding data stored in the device used for verification, for example (see abstract; column 5, line 44 through column 6, lines 18-45; and column 7, lines 8-28). One of the advantages is that users do not have to memorize PIN numbers, for example (see column

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2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of **Findley, Jr. et al** to provide a card that also contains a card identification number and associated PIN number wherein the checking process is performed by comparing card ID and PIN with corresponding data stored in the device used for verification in order to compare data specific to individual card and card user and to authenticate the card without user intervention or without having to memorize PIN numbers as taught by **Sloan**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Sloan** so as to compare data specific to individual card and card user and to authenticate the card without user intervention or without having to memorize PIN numbers.

As per claim 17, **Findley, Jr. et al** discloses different embodiments and access control of the invention wherein one device is located in a trusted environment, for example (see column 5, lines 1-25).

As per claims 20-22, 36-38, and 43-45, **Findley, Jr. et al** discloses the limitation of wherein the performing card holder verification comprises automatically obtaining a personal identification number of the holder of the card and verifying the personal identification number without intervention of the holder of the card, wherein the checking comprising comparing a card identifier stored on the card with one or more card identifiers stored in the device, for example (see column 7, lines 14-67; column 2, lines 1-30 lines 35-58; column 7, lines 10-20).

As per claims 23 and 26, **Findley, Jr. et al** discloses updating a PIN/password that meets the recitation of replacing the personal identification number with another personal identification number, for example (see column 9, lines 15-40 and column 3). **Findley, Jr. et al** discloses that the smart card disclosed can also be implemented as other card application well known in the art such as pay phone or ATM, etc. **Findley, Jr. et al** further discloses that the card can even be used as a multiple access card, for example (see column 10, lines 14-30). It is very well known that the card identifier as disclosed above is associated with a personal identification number usable in card holder verification. **Sloan** also discloses card ID associated with password and the replacing or erasing of data association, for example (see column 5). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of **Findley, Jr. et al** to provide a card identifier associated with a personal identification number usable in card holder verification as it is very well known in the art. For example a bank card has an identifier associated with the user PIN or password. Another example is a cable box has at least a device identifier corresponding to a card identifier. This modification does not depart from the spirit and scope of the invention disclosed by **Findley, Jr. et al**. Claims 23 and 26 are also rejected on the same rationale as the rejection of independent claims 16, 34 and 41 above.

Claims 24-25, 27, 39, and 46 recite the same inventive concept as claims 22-23 and 26. Therefore they are rejected on the same rationale as the rejection of claims 22-23 and 26.

As per claim 28 Findley, Jr. et al discloses the limitation of further comprising performing in response to the checking indicating no trusted association, card holder verification which comprises card holder intervention, for example (see column 4, lines 39-46).

As per claims 29-32 Findley, Jr. et al discloses the limitation of controlling association between the at least one device and the card using a network connectable to the device, and wherein the checking is between at least one device and a plurality of cards and where in the suppressing is for a plurality of holders, for example (see figure 11).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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5.1 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as the art discloses the use of cards and terminal devices with capability for storing and matching identification codes and plurality of other data and discloses many of the claimed features.

US Patents: 4,810,862 Nakano et al; 5,585,787 Wallerstein;
3,866,173 Moorman et al; 6,111,951 Guenther; 6,298,441 Handelsman et al.

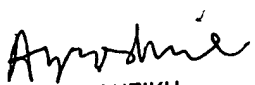
5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 571-272-3862. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Carl Colin
Patent Examiner
November 22, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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